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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,203	04/28/2000	Terry Erisman	TEE 2000-1	3365

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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,203

Applicant(s)

ERISMAN, TERRY

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt of Amendment and Remarks filed March 11, 2004. Claims 1-102 remain pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. Applicant's arguments and amendments filed March 11, 2004 have been fully considered but they are not persuasive. All rejections from previous Office Action are maintained. The Examiner has provided art to cover the previously presented claim language. The applicant has amended the claims with new claim language that is addressed in the rejection below using the same art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6,044,363) in view of Barzilai (US 6,012, 045) in view of Godin (US 6,266, 652) in view of Aggarwal (US 6,151, 589) and in further view of Rackson (US 6,266,652). Rejections from the previous Office Action are maintained.

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Newly presented claim language is as follows:

In claims 1, 11, 71, 76, 81, 88, 92, 94 applicant cites "...such that the electronic auction determines at most a single item to be awarded to the bidder from the set of ranked bids by correlating a ranking relationship between separate items bid on by said bidder. "

In claims 23, 81 applicant cites "wherein each of said N items differ from each other and are separately biddable during said common auction expiration period." And "such that at most a single item is awarded to said bidder by correlating said set of N bids on said set of N items made by said bidder"

In claim 27, cites " wherein both the first bid and said second bid are considered at the same time by a single auction resolution system which resolves and identifies a winning bid for said first auction item and second auction item respectively",

In claims 30, 34, 37, 44, 84 applicant cites "by ranking relationship between separate items bid on by such a purchaser", and

In claim 65, cites "based on correlating a ranking relationship between said plurality of ranked bids made on separate items bid on by such user. "

It is respectfully submitted that references, in determining obviousness are not read in isolation, but for what they fairly teach in combination with the prior art as a whole and thus patent assignees reference-by-reference attack on prior art to demonstrate non-obviousness is not persuasive [(Photoelectric sensing system) banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing In re Merck, 231 USPQ 375 (CAFC 1986)].

Moreover, in the Examiner's opinion, the newly presented limitations do not present claim language that distinguishes over the prior art presented to the applicant. For example,

"...Barzilia teaches creating a bid ranking and bid table (see col. 16, lines 50-60; and col. 16, lines 17-21)... running average, the mean, median, mode and range per bid item and posting of the top N bids above a threshold on the bid chart" (see Office Action page 3, lines 10+)

"Aggarwal teaches providing display of current best bids... information regarding the best bids submitted...highest bid ranking among all bids submitted to the purchaser...priority given to bidders with the highest volume..." (see Office Action, page 4 lines 6+)

Rackson a multi-auction wherein the electronic auction determines at most a single item to be awarded (see 550, fig. 14) to said bidder from said ranked bids by correlating a ranking relationship items on bid on by the bidder (see Office Action page 4, line 15 to page 5, line 2, see also Rackson col. 25, lines 56 to col. 26, line 29).

The applicant mentions that Mori fails to teach an auction type where the bids are treated as mutually exclusive. Rackson teaches this feature and a motivation has been given to combine Mori with Rackson. However, to further expound upon the reasoning given in the previous Office Action, It would have been obvious for an artisan at the time of the invention to modify Mori to provide multi-bid service as an extension to making single transactions on open networks such as the Internet, wherein the auction process described in Mori may be modified to display a plurality of correlated auction items

and/or bidder information as taught by Rackson (see Rackson, col. 8, lines 49+). Thus such a modification would have been considered an obvious expedient well within the ordinary skill in the art.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
May 27, 2004

Daniel S Felten
Examiner
Art Unit 3624



**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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